THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS C. ARTER and MOHAN S. SAINT

Appeal No. 95-4298
Application No. 07/886,263[1]

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed May 20, 1992.

This appeal was taken from the examiner's decision rejecting claims 1, 3 through 9 and 11 through 20, which are all of the claims remaining in the application.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. An analytical element useful for the determination of prostatic acid phosphatase in an aqueous specimen comprising:

a porous spreading zone containing

(a) a nonhygroscopic aromatic phosphate which reacts as a substrate with prostatic acid phosphatase to produce a phenol reaction product, said nonhygroscopic aromatic phosphate substrate being an alkaline earth salt of an aryl phosphate ester, and

(b) a diazonium or tetrazolium salt which is capable of reacting with said phenol reaction product to provide a chromophore,

said element further comprising a buffer which maintains said element at a pH of from about 3 to about 6.5 when contacted with an aqueous specimen.

The references relied on by the examiner are:

Schnabel et al. (Schnabel)	4,758,508	Jul. 19, 1988
Katsuyama (Japanese Kokai patent application)	63-88000	Apr. 19, 1988

Marie Pernicova, "Proof of Prostatic Acid Phosphtase Activity in Gel Carriers," Scripta Medica 259-64 (1971)

The issue presented for review is whether the examiner erred in rejecting claims 1, 3 through 9 and 11 through 20 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Pernicova, Katsuyama and Schnabel.

On consideration of the record, we reverse the examiner's prior art rejection.

DISCUSSION

First, we conclude that the examiner has not established a prima facie case of obviousness for the reasons succinctly stated in appellants' Appeal Brief.

Second, assuming arguendo that the examiner had established a prima facie case of obviousness, the objective evidence of nonobviousness relied on by appellants and set forth in Example 1 of the specification, pages 14 through 16, is sufficient to rebut any such prima facie case.

Respecting the latter point, we remind the examiner that if a prima facie case of obviousness is established, and if the applicant comes forward with reasonable rebuttal supported by experimental evidence, the entire merits of the matter are to be reweighed. As stated in In re Hedges, 783 F.2d 1038, 1039,

228 USPQ 685, 686 (Fed. Cir. 1986):

> If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. [Emphasis added, citation omitted].

This the examiner did not do. The Examiner's Answer does not come to grips with appellants' objective evidence of nonobviousness, set forth in Example 1 of the specification and relied on for patentability in the Appeal Brief.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS Administrative Patent Judge	)	
WILLIAM F. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HUBERT C. LORIN Administrative Patent Judge	)	

clm

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